

REMARKS

I. Introductory Comments

Claims 16-26 and 43-53 were pending in the application. In the Office Action, the Examiner requested that Applicants update the status of Application No. 09/638.166 in the specification. Applicants have updated the specification accordingly. Moreover, claims 16–26 and 43–53 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse the rejection.

To facilitate prosecution, claims 16 and 43-53 are amended. Accordingly, all of the pending claims are now in condition for allowance. In view of the claim amendments and the following arguments, all claims are believed to be in condition for allowance. Therefore, this response is believed to be a complete response to the Office Action.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

II. Claims 16-26 And 43-53 Are Directed To Statutory Subject Matter Under Section 101

The Examiner alleged that claims 16 and 43, as well as claims 17-26 and 44-43 depending therefrom, are directed to non-statutory subject matter under Section 101. Specifically, the Examiner alleged that “Independent claim 16 is directed to a method that can be interpreted as a program,” and that “Independent claim 43 is directed to a system that can be interpreted as a program.” (Office Action, page 2.) The Examiner further quoted from MPEP 2106.01.I, and stated that:

¹ As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

(Office Action, pages 2-3.) Additionally, the Examiner suggested that "Hardware can be added to these independent claims (method implemented in hardware; system implemented in hardware) in order to overcome the 35 USC 101 rejection." (Office Action, page 4.)

The Examiner did not rely on any recent case law to support his position, nor did the Examiner apply the PTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (October 26, 2005). However, since the Examiner issued the Office Action, the Court of Appeals for the Federal Circuit addressed the issue of statutory subject matter in *In re Bilski*, 2007-1130 (Fed. Cir. Oct. 30, 2008). Notably, while discussing the now controlling "machine-transformation test" for determining statutory subject matter under Section 101, the Federal Circuit stated that "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus." (*Bilski* at 24).

Accordingly, independent claim 16 has been amended, and now includes the following recitations:

- "utilizing a computer for electronically defining a Gateway domain name for one or more Zones in an H 323 network, each Zone comprising a set of one or more Gateways;"
- "obtaining by utilizing the computer, from a Gatekeeper associated with the H 323 network, utilization data concerning one or more Gateways in one or more of the Zones;"
- "generating a lookup table by utilizing the computer, the lookup table electronically stored on the computer and comprising a Gateway domain name for one or more of the

Zones, the utilization data with respect to one or more of the Gateways in the Zones obtained from the Gatekeeper, and an IP address for one or more of the Gateways in the Zones;”

Independent claims 43 has also been amended, and is now directed to “[a] computing system.” Claims 44-53, depending directly or indirectly from independent claim 43, have also been amended each to be directed a “computing system” that is “further configured.”

Amended claims 16 and 43, as well as all claims depending therefrom, are clearly “tied to a particular machine or apparatus,” thus addressing both the Examiner’s concerns and complying with the Federal Circuit’s “machine-transformation test” as discussed in the recent Bilski decision. Therefore, claims 16 and 43, as well as claims 17-26 and 44-53 depending therefrom, recite statutory subject matter under Section 101. Applicants therefore respectfully request the Examiner to withdraw the Section 101 rejections of claims 16-36 and 44-53.

CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65632-0588 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to this deposit account.

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Respectfully submitted,

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